

REMARKS

No Claims have been amended.

Claims 1-27 have been cancelled without prejudice.

Claims 28-40 are currently pending in this application.

Claims 28, 30, 32, 33, 34, 36, 37, and 40 are in independent format.

1. *Restrictions*

The Examiner has requested restriction of the pending claims in the present application between claims 1-15 identified as Group I, claims 16-20 identified as Group II, claims 21-27 identified as Group III, and claims 28-40 identified as Group IV. Applicant respectfully notes that this restriction has been issued after an action on the merits of the original claims, in which a significant number of the original claims were either allowed or objected to.

Accordingly, Applicant hereby elects to proceed with claims 28-48, identified as Group IV, and cancels Claims 1-27 without prejudice with respect to the filing of any continuations or divisional applications.

Applicant further notes that Claims 34-40 were previously indicated as allowable. Claims 30 and 32 where previously indicated as objected to, and were amended in the Applicant's response of November 1, 2004 to overcome the cited objections.

Claims 28, 29, and 31 were 33 were previously rejected by the Examiner under 35 U.S.C. § 102(e) over U.S. Patent No. 6,481,282 to *Douglas*. Applicant's arguments overcoming this rejection were originally set forth in Applicant's response of November 1, 2004, and are herein restated for convenience of the Examiner.

2. Rejections Under 35 U.S.C. § 102(e)

The Examiner's rejections of Claims 28, 29, 31, and 33 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,481,282 B2 to *Douglas et al.* are respectfully traversed.

The MPEP §2131 provides:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

Contrary to the Examiner's statement that all of the required steps of the method set forth in of independent Claim 28, and further expanded in dependent Claims 29, 31, and 33, are disclosed in the '282 *Douglas et al.* patent, the required step of calculating an imbalance correction weight threshold level for each of the imbalance parameters, utilizing an identified dimension of the rotating body and a selected associated imbalance limit is not. Hence, the rejection of Claims 28, 29, 31, and 33 is unsupported by the '282 *Douglas et al.* patent, and should be withdrawn.

The Examiner has not specifically identified any disclosure in the '282 *Douglas et al.* patent which specifically supports a rejection under 35 U.S.C. § 102(e) of Claims 28, 29, 31, and 33. While the Examiner has identified that the '282 *Douglas et al.* reference discloses identifying a dimension of a rotating body, determining a magnitude and position of an imbalance correction weight, and determining a "threshold amount", these disclosed elements are disjoint and are not utilized as required by the limitations

of Claim 28. Furthermore, the “threshold amount” disclosed in the ‘282 *Douglas et al.* patent, described at Col. 8, lines 5-9, is associated with measurements of wheel rim run-out, and is not an imbalance correction weight threshold level, as required by independent Claim 28. Hence, the ‘282 *Douglas et al.* patent fails to disclose the required step of calculating an imbalance correction weight threshold level for each of the imbalance parameters utilizing an identified dimension of the rotating body together with a selected associated imbalance limit, and the rejection of Claim 28 under 35 U.S.C. § 102(e) is unsupported.

Dependent Claims 29, 31, and 33 each depend either directly or indirectly from independent Claim 28, and accordingly, each require the same method step of calculating an imbalance correction weight threshold level for each of the imbalance parameters utilizing an identified dimension of the rotating body together with a selected associated imbalance limit. Since the ‘282 *Douglas et al.* reference fails to disclose the required step set forth in independent parent Claim 28, the rejections under 35 U.S.C. § 102(e) of dependent Claims 29, 31, and 33, which depend either directly or indirectly from Claim 28, are similarly unsupported, and rejections should be withdrawn for the same reason.

3. Conclusion

Based on the foregoing, the allowance of claims 28-40 is requested.

If for any reason the Examiner is unable to allow the application on the next Office Action and feels that an interview would be helpful to resolve any remaining issues, the Examiner is respectfully requested to contact the undersigned attorney for the purpose of arranging such an interview.

Respectfully submitted,

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